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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,527	12/27/2001	Raymond L. Houghton	210121.513C1	7914

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EXAMINER

WILDER, CYNTHIA B

ART UNIT	PAPER NUMBER
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1637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/033,527

Applicant(s)

HOUGHTON ET AL.

Examiner

Cynthia B. Wilder, Ph.D.

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37,40,41 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37,41,45 and 46 is/are rejected.
- 7) ☐ Claim(s) 40 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. Upon further consideration, finality of the Office action mailed on 12/28/2006 is withdrawn in lieu of the new grounds of rejection in this Office action. Claims 1-36, 38-39 and 42-43 have been canceled. Claims 37, 40-41, and 44-46 are pending and discussed in this Office Action.

New Grounds of Rejection

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 37 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Frudakis et al (US 6586570 B1, filing date April 1999). Regarding claims 37, Frudakis et al teach a composition for detecting a breast cancer cell in a biological sample of a patient, said composition comprising (a) a first oligonucleotide, (b) a second oligonucleotide, wherein said first oligonucleotide and said second oligonucleotide hybridize to a first polynucleotide, or the complement thereof and to a second polynucleotide or the complement thereof, respectively, wherein said first polynucleotide and said second polynucleotide comprise a sequence depicted in SEQ ID NO: 7 (see

Art Unit: 1637

SEQ ID NO: 303, col. 9, lines 26-29; col. 14, 18-24 and 40-62; and col. 21, lines 27-50).

Therefore, Frudakis et al meet the limitation of claim 37 as broadly written.

3. Claims 37 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Xu et al (US 6395278, filing date July 1999). Regarding claim 37 and 41, Xu et al teach a composition for detecting prostate cancer cells in a biological sample, said composition comprising (a) a first oligonucleotide or oligonucleotide pair; (b) a second oligonucleotide or oligonucleotide pair; wherein said first and second oligonucleotide pair hybridize to a first polynucleotide, or the complement thereof, and to a second polynucleotide or the complement thereof respectively, wherein said first and second polynucleotide comprise a sequence depicted in SEQ ID NO: 7 (See SEQ ID NO: 375, col. 40, lines 45-65 and col. 41, lines 36-45). Therefore, Xu et al meet the limitations of the claims recited above as broadly written.

4. Claim 37 is rejected under 35 U.S.C. 102(e) as being anticipated by Weaver (20020165180, effective filing date September 2000). Regarding claim 37, Weaver teaches a composition for detecting breast cancer cells in a biological sample, said composition comprising (a) a first oligonucleotide (b) a second oligonucleotide; wherein said first and second oligonucleotide hybridize to a first polynucleotide, or the complement thereof, and to a second polynucleotide or the complement thereof respectively, wherein said first and second polynucleotide comprise a sequence depicted in SEQ ID NO: 75 (See SEQ ID NO: 1034, paragraphs 0053, 0073, 0081,

Art Unit: 1637

0082, and 0090). Therefore, Weaver meets the limitation of the claims as broadly written.

5. Claims 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Jing (20020151695, effective filing date November 2000). Regarding claims 45 and 46, Jing et al teach a composition comprising an oligonucleotide primer having 15 consecutive nucleotides that are identical to the nucleotide sequence depicted in SEQ ID NO: 53 (see SEQ ID NO: 20, page 41 and 42). Therefore, Jing et al meet the limitations of the claims recited above.

Conclusion

5. The claims 37, 41, 45 and 46 are not allowed. The claims 40 and 44 are objected because they depend from rejected claims.

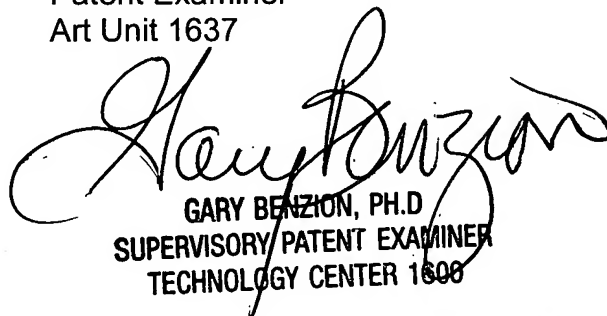
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner can normally be reached on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1637

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cynthia B. Wilder, Ph.D.
Patent Examiner
Art Unit 1637


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